

REMARKS

This response is a duplicate of the response filed on June 10, 2005. Through a clerical error, the incorrect application number was entered for this response. This fact was confirmed with a discussion with the Examiner on December 7, 2005. Further, it was acknowledged that the Applicant's response of June 10, 2005 was filed in a timely manner. Accordingly, no additional fees are due with this paper.

Claims 1-11 are pending in the present application.

Claims 1-4 and 7-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Maeda* ("Management and Control of Transparent Optical Networks", IEEE Journal on Selected Areas in Communication, Vol. 17, No. 7, September 1998) in view of *Chaudhuri et al.* (US App 2002/0030864A1).

Claims 5-6 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Maeda* ("Management and Control of Transparent Optical Networks", IEEE Journal on Selected Areas in Communication, Vol. 17, No. 7, September 1998) in view of *Chaudhuri et al.* (US App 2002/0030864A1) and further in view of *Ashwood Smith* (US Patent 6,738,354).

Claims 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Maeda* ("Management and Control of Transparent Optical Networks", IEEE Journal on Selected Areas in Communication, Vol. 17, No. 7, September 1998) in view of *Chaudhuri et al.* (US App 2002/0030864A1) and *Ashwood Smith* (US Patent 6,738,354) and further in view of *Okamura* (US Patent 6,618,400B1). Applicant respectfully traverses these rejection. Favorable reconsideration is requested.

Specifically, as the Office Action recognizes, *Maeda* does not teach using connection vectors for identifying available WDM transmission channels, as recited in independent claim 1. To this end, the Office Action claims that *Chaudhuri* teaches in [0092] to use a vector of the same size as the number of wavelengths for probing messages to determine appropriate wavelength choice, and as such renders the claim obvious. Applicant respectfully disagrees.

Chaudhuri teaches the usage of one vector to identify available WDM transmission channels between two network nodes. However, the optical network described in *Chaudhuri* does not utilize wavelength converters as required in the present claims, and is explicitly relied

upon in *Maeda* (see p. 1009, section II). As such, one having ordinary skill in the art would have to teaching, suggestion or motivation to combine the references in the manner suggested in the Office Action.

The Patent Office has the initial burden of proving a *prima facie* case of obviousness. *In re Rijckaert*, 28 U.S.P.Q. 2d 1955, 1956 (Fed. Cir. 1993). In making this determination, the question is not whether the differences between the prior art and the claims themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 U.S.P.Q. 871 (Fed. Cir. 1983)(emphasis added). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

The present claims recite, and the supporting text in the specification teach a method for improving the setting-up of a connection in at least one optical WDM transmission system with a number of switchable optical network nodes, of which at least one has a wavelength converter (see claim 1; specification, page 3, lines 11-13). It simply makes no sense to combine the aforementioned references to this end. as the usage of one vector in conjunction with a wavelength-interchanging cross connect has the disadvantage that it can be implemented only to a restricted extent (also addressed in the present specification on (page 3, lines 8-9), as the capability of wavelength conversions can not be used with one vector.

Furthermore, there is no teaching in either of the references to use a further (second) vector as recited in the claims. Regarding the further vector, there are additional considerations to implement this configuration that are not addressed at all in any of the cited references, especially when considering matters such as generation, management and transmission of the vector. To submit that the addition of a second vector, regardless of the context, is obvious is improper, and further relies on impermissible hindsight in its conclusion.

Applicants submit that the rejection under 35 U.S.C. §103 is improper and should be withdrawn. As claims 5-6, 9 and 10 depend from claim 1, they are also patentable for the same reasons given above. In light of the above remarks, Applicant submit that the application is in condition for allowance and request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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